

No. 18177

---

---

**United States Court of Appeals**  
**For the Ninth Circuit**

---

AMERIO CONTACT PLATE FREEZERS, INC., *Appellant*,

vs.

BELT ICE CORPORATION and FRANK W. KNOWLES,  
*Appellees.*

---

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR  
THE WESTERN DISTRICT OF WASHINGTON,  
NORTHERN DIVISION

---

**REPLY BRIEF OF APPELLANT**

ROBERT W. GRAHAM

J. KENNETH BRODY

FORD E. SMITH

*Attorneys for Appellant.*

14th Floor Norton Building,  
Seattle, Washington.

FILED

NOV 28 1952

FRANK E. SCHMID, CLERK



**United States Court of Appeals**  
**For the Ninth Circuit**

---

AMERIO CONTACT PLATE FREEZERS, INC., *Appellant*,

vs.

BELT ICE CORPORATION and FRANK W. KNOWLES,  
*Appellees.*

---

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR  
THE WESTERN DISTRICT OF WASHINGTON,  
NORTHERN DIVISION

**REPLY BRIEF OF APPELLANT**

ROBERT W. GRAHAM

J. KENNETH BRODY

FORD E. SMITH

*Attorneys for Appellant.*

14th Floor Norton Building,  
Seattle, Washington.



## INDEX

	Page
I. The "On-Sale" Issue.....	1
A. The Facts .....	1
B. The Facts Relied on by Appellees.....	3
C. Position of Appellant.....	4
D. The Position of Appellees.....	7
II. The Bar of 35 U.S.C. § 135.....	12
A. Appellant Is Not Estopped by <i>Res Judicata</i> to Assert this Statutory Bar.....	13
B. The Issue Presented.....	14
C. The Differences Between Knowles' Original and Amended Application Claims Are of Patentable Significance .....	15
Conclusion .....	18
Certificate of Counsel.....	18
Appendices A, B, C, D, E, F, G and H.....	following page 18

## TABLE OF CASES

<i>Andrews v. Hovey</i> (1887) 123 U.S. 267, 8 S.Ct. 101, 31 L.Ed. 160 .....	7
<i>Browning Manufacturing Co. v. Bros. Incorporated</i> (D.C. Minn., 1962) 134 U.S. P.Q. 231, — F.Supp.....	10
<i>Burke Electric Co. v. Independent Pneumatic Tool Co.</i> (C.A. 2, 1916) 232 Fed. 145.....	8, 10, 11
<i>Campbell v. Mayor, etc. of New York</i> (C.C. S.D. N.Y. 1888) 36 Fed. 260.....	9
<i>Chicopee Manufacturing Corp. v. Columbus Fiber Mills Co.</i> (M.D. Ga. 1958) 165 F.Supp. 307.....	11
<i>Connecticut Paper Products v. New York Paper Co.</i> (D.C. Md. 1941) 39 F.Supp. 127.....	10
<i>Egbert v. Lippmann</i> (1881) 104 U.S. 333, 26 L.Ed. 755.....	7
<i>Hutten v. Frank Krementz Co.</i> (C.A. 3, 1916) 231 Fed. 973.....	9
<i>McCreery Engineering Co. v. Massachusetts Fan Co.</i> (C.A. 1, 1912) 195 Fed. 498.....	8, 10
<i>Magee v. Coca Cola Co.</i> (C.A. 7, 1956) 232 F.(2d) 596.....	11

<i>Metallizing Engineering Co. v. Kenyon Bearing &amp; Auto Parts Co.</i> (C.A. 2, 1946) 153 F.(2d) 516.....	4, 5
<i>F. E. Myers &amp; Bro. Co. v. Gould Pumps, Inc.</i> (W.D. N.Y., 1950) 91 F.Supp. 475.....	10
<i>Philco Corp. v. Admiral Corp.</i> (D.C. Del., 1961) 199 F. Supp. 797 .....	4, 11
<i>Rieser v. Williams</i> , C.C.P.A., 255 F.(2d) 419 (1958).....	14
<i>B. F. Sturtevant Co. v. Massachusetts Hair &amp; Felt Co.</i> (C.A. 1, 1941) 122 F.(2d) 900, reh. den. 124 F.(2d) 95....	9
<i>Trico Products Corporation v. Delman Company</i> (S.D. Iowa, 1961) 199 F.Supp. 231.....	9
<i>Watson v. Allen</i> (C.A. D.C., 1958) 254 F.(2d) 342.....	6, 7
<i>Wende v. Horine</i> (C.A. 7, 1915) 225 Fed. 501.....	11

### STATUTES

35 U.S.C. § 135, 66 Stat. 801.....	12, 13, 14, 15, 18
35 U.S.C. § 102.....	14

### RULES

Patent Office Manual, § 1101.02(f).....	14
Rule 292, Rules of Practice, United States Patent Office, 35 U.S.C. Apx. 1.292, p. 740.....	11





Granted that appellees have not taken substantial issue with the narrative history presented by appellant, there is, as pointed out in appellant's brief, p. 25, a critical dispute as to certain facts or factual conclusions involved. That dispute involves a crucial issue—whether Knowles was in fact building two freezers incorporating the invention to the special order of Evergreen prior to May 23, 1951, or whether they were built “on speculation.”

In this dispute, although there are two sides, there is only one disputant—Knowles. In his 1958 testimony in Interference No. 88,174, Knowles stated directly that, following the construction of the prototype, he sold two freezers to Evergreen from the prototype and the preliminary sketches. He said that he ordered Dole refrigerating plates in January, 1951, because he had taken an order for two package freezers from Evergreen, having verbally agreed that delivery would be made the first of June so that the plant would be ready for peas about the first of July.<sup>2</sup>

Nevertheless, at the trial, Knowles testified that the thirty Dole plates had been ordered “purely on speculation” (Tr. Vol. 3, 317), and that he built the two freezers on “speculation and didn't get an order for them until June some time” (Tr. Vol. 3, 318).

The ultimate truth is not consistent with the two positions that Knowles has taken. That is why his credibility is of significant importance. We cannot, therefore, agree with appellees that our discussion of credibility is “. . . apparently presented simply to create in the mind of the court prejudice against Knowles on the basis of matters not here involved.” (Appellees' brief, pp. 48-49).

---

<sup>2</sup>See pp. 9-11, appellant's brief.



## B. The Facts Relied on by Appellees.

Appellees have not attempted to analyze and assess the importance of *all* of the facts in this case. Instead, they have attempted to isolate two factual issues and have rested their case upon these two asserted facts.

The first such asserted fact is that there was no completed and fully operational machine in existence on May 23, 1951. The second asserted fact is that no sale document had been executed on or before that date.

As to the first, it is undisputed that one machine was complete by May 23, 1951, save only for refrigerating plates. These were standard elements which Knowles knew would work and had only to insert. The invention itself was in working order, capable of achieving the necessary spacing.<sup>3</sup> As to the second, the purchase order for the two machines was dated June 23, 1961—after the machines had been shipped to Evergreen on June 19 and 21.<sup>4</sup>

We have attempted to compile and to analyze all of the significant facts. We do not think it necessary to repeat that narration and analysis here. Beyond the explicit sworn testimony of Knowles that he sold two freezers to Evergreen from the prototype, having taken an order for two package freezers for delivery on the first of June for the 1951 pea crop, we believe that the entire record demonstrates a vendor-vendee relationship between appellees and Evergreen, commencing in December, 1950. As we have pointed out, Evergreen not only ordered the two freezers, but it constructed a special room to house them, built to the drawings of Knowles. Evergreen relied upon this freezing capacity, not only for the 1951 pea crop, but also for other 1951 crops. The record leaves no doubt that Evergreen knew what it was buying as early as December, 1950, and that Belt Ice

---

<sup>3</sup> See p. 11, appellant's brief.

<sup>4</sup> See p. 30, appellant's brief.

proceeded, as expeditiously as possible, to construct two machines for the use and to the order of Evergreen.

It is significant to note from the chronological narrative involved that there was no suggestion that the machine would have to be experimentally tested or would be subject to further development and experimentation before Evergreen would make its decision to buy. That Evergreen had made its purchase decision as early as December 20, 1950, is clear (Ex. 50, entry of December 20, 1950). This in turn reflects upon the size and character of the mockup. Far from being an insubstantial thing of "scrap lumber," it performed so well as to sell two freezers to Evergreen. Examination of the photograph, Ex. 4, will serve to clarify this point.

We believe that appellees' failure to consider all of the facts contained in the record has led to a legal analysis on their part which is too narrow and restrictive to give meaning to the statute. We believe that the facts of this case, as summarized in appellant's brief, and the statutory language alone would be sufficient to dispose of this case.

### **C. Position of Appellant.**

We have discussed, at pages 19-22 of appellant's brief, our concept of the policy of the statute involved. The policy is clear and understandable. Appellees have stated, at page 22 of their brief, that:

"Appellant does not really explain its understanding of 'competitive use,' nor does it clearly apply that term to the facts of the present case. It mentions 'competitive sales effort,' but there is no proof of competing sales in this case."

In *Philco Corp. v. Admiral Corp.* (D.C. Del., 1961), 199 F. Supp. 797, the court relied upon Judge Hand's discussion and decision in *Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.* (C.A. 2, 1946), 153 F.(2d) 516, stating:

“Judge Learned Hand held that an inventor cannot be allowed to use his device competitively more than one year prior to his patent application no matter how little the public learns of the invention. It was reasoned that such a competitive use prior to a patent application is the effective equivalent of an extension of the patent monopoly.” (199 F. Supp. at 816).

What appellees do not understand, perhaps, is the policy which the court in *Philco* said had been “delineated so cogently” in *Metallizing*. But at the quoted juncture of their brief, appellees do not attempt to analyze the facts or the opinion in *Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.*, (C.A. 2, 1946), 153 F.(2d) 516. Their discussion of this case, at page 10 of their brief, is limited to an attempt to distinguish it on the basis that the device in *Metallizing* was in commercial use for more than one year prior to the filing of the patent application. Such a limited analysis does not lead to an understanding of the policy significance of the decision which, admittedly, dealt with the “public use” rather than the “on sale” portion of the statute.

We believe that the various attempts by appellees to sell their invention in late 1950 and early 1951, and more specifically the relationship with Evergreen which, commencing in December, 1950, in one continuing and connected transaction led to the sale of two machines, constituted a true competitive use of the invention — an invention which Knowles’ affidavits and sworn testimony make clear had been reduced to practice.<sup>5</sup> To make an invention commercially available, to take orders for it, and to construct two machines for specific delivery and ultimate payment on the basis of these actions is a use of the invention competitive with any other invention or machine which Evergreen might have purchased for use in the 1951 freezing season.

Appellees state, at page 6 of their brief:

<sup>5</sup>See appellant’s brief, pp. 5-6.

“ . . . that the invention of the Knowles patent could only be offered for sale as embodied in a full-sized working machine.”

We think the facts of this case show that the invention was in fact offered for sale on the basis of the mockup or prototype and was successfully sold in that manner. Likewise, we do not understand the statement of appellees, at page 23 of their brief, that:

“ . . . An ‘invention’ has no existence apart from its embodiment in a machine . . . ”

Apparently the invention had a substantial enough existence in December, 1950, and certainly in January, 1951, to persuade Evergreen that it should utilize this invention in its 1951 operations and could count on doing so.

Appellees have queried (appellees brief, p. 23) the observation of appellant that a restatement of the underlying policy of the statute is found in *Watson v. Allen* (C.A. D.C., 1958), 254 F(2d) 342. That case dealt with “public use,” but the following portions of the court’s opinion are significant:

“It may be fair to conclude that public use exists where the invention is used by or exposed to any one other than the inventor or persons under an obligation of secrecy to the inventor. Under such sweeping interpretations, we have no choice but to conclude that the appellee’s shims were in public use even though the buyer did not know of the presence of the shims in the car . . .

“The cases seem to be hospitable to the inventor during the *experimental stage* of his invention, but become disposed to construe the law against him thereafter. The judicial policy underlying this rule has been said to be that an inventor acquires an undue advantage over the public by delaying to take out a patent inasmuch as he thereby preserves the monopoly to himself for a longer period than the law allows. . . . “ . . . Our conclusion is that the courts accord considerable hospitality to the inventor during the experi-



mental stage. However, as a limitation we note that this hospitality disappears even during the experimental stage when the 'experimental motive' wanes, or is superseded by a profit motive, or is tainted by careless acts of the inventor." 254 F.(2d) at 345-346.

Surely the whole relationship between appellees and Evergreen was based upon the profit motive of exploiting appellee's invention. Nor was it a generalized profit motive such as the showing of an invention in the hope of obtaining customer interest. Seller and buyer knew at all times what they intended to do. The seller's demonstration of the invention, his undertaking to build two machines for the buyer, and his activity to that end, long before May 23, 1951, were all in quest of financial gain from this invention.

We have cited *Egbert v. Lippmann* (1881), 104 U.S. 333, 26 L. Ed. 755, for the proposition that a single instance of use will suffice to raise the statutory barrier, and it is immaterial that the invention is given without profit, or that it is invisible to the public eye. Indeed, *Andrews v. Hovey* (1887), 123 U.S. 267, 8 S. Ct. 101, 31 L. Ed. 160, carries this doctrine one step farther and holds that it is immaterial that the use is without the inventor's consent, or due to factors not his fault and beyond his control.

If a single, non-experimental use beyond the cutoff date invalidates the patent, the words "on sale" are surplusage unless they signify something different from "public use." "On sale" must mean something different from and at the same time less than the single instance of public use prescribed by the cases. It means a placing "on sale" even if the sale is never made. It means, as we understand the doctrine, a competitive effort, whether or not a sale takes place.

#### **D. The Position of Appellees.**

Appellees take the position that the on sale doctrine may be invoked only when there exist: (1) a "full-sized work-

ing machine''<sup>6</sup> available for sale and delivery, and (2) a completed sale,<sup>7</sup> as such would be defined under the law of sales.

The cases are numerous and conflicting. Appellees rely on language which is in many cases purely dictum. Few decisions attempt to offer a rationale for the statute. Since this case will establish a precedent governing this circuit, we believe its decision must be based upon a sound analysis of the purpose and intent of the statute, as well as the language of cases all of which cannot perhaps be reconciled.

Turning to the cases relied upon by appellees, the decision in *McCreery Engineering Co. v. Massachusetts Fan Co.* (C.A. 1, 1912), 195 Fed. 498, makes it clear that there had been no reduction to practice prior to the cutoff date. This is the time basis of the decision. The court concluded that the drawings and verbal descriptions on which the agreement was based, however completely they might show conception, would not establish reduction to practice unless filed as a patent application which accomplishes a constructive reduction to practice. Knowles' sworn preliminary statements<sup>8</sup> (Ex. 37 and 38) show reduction to practice by October, 1950.<sup>9</sup> Without reduction to practice, there cannot be a competitive use. *McCreery* therefore accords with the appellant's position.

In *Burke Electric Co. v. Independent Pneumatic Tool Co.* (C.A. 2, 1916), 232 Fed. 145, the motor was delivered on

---

<sup>6</sup> Appellees' brief, p. 6.

<sup>7</sup> See pp. 20-21, appellees' brief.

<sup>8</sup> The use of the word "affidavit" in appellant's brief was intended to do more than indicate that the preliminary statements were in fact sworn statements. Appellees complain of our drawing attention to the inconsistency in Knowles' preliminary statements "without further explanation" (appellees' brief, p. 46). An issue which inheres throughout the case, it may be noted, is that of Knowles' credibility. See p. .... *supra*.

<sup>9</sup> See appellant's brief, pp. 5-6.

September 9, 1909. The motor delivered was a "first sample . . . subject to your approval."

This was properly held to be a sale by sample. The sample was not submitted till after the cutoff date. The inventor could have changed the motor at any time prior to delivery and the buyer need not have accepted it. The invention and the device were not in final form prior to the cutoff date. Further experiment or change was indicated as possible and acceptable. The case simply recognizes that unless an invention has been reduced to practice and final in its form, it cannot be said a competitive use has been made of it.

In *Campbell v. Mayor, etc. of New York* (C.C. S.D. N.Y., 1888), 36 Fed. 260, the issue was purely procedural and plaintiff was given leave to take and file testimony as to whether the engine sold actually incorporated the invention and as to fraudulent and surreptitious use of the invention prior to the cutoff date. The discussion of the on sale doctrine appears to be dictum. As with all cases in the Second Circuit, including *Burke*, we believe they must be considered as modified by the *Metallizing* decision insofar as they may be in conflict with it.

*B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co.*, (C.A. 1, 1941), 1922 P.(2d) 900, reh. den. 124 F.(2d) 95 is difficult to follow on the facts. Analysis of the case would appear to indicate that the whole discussion of the on sale defense raised as to the second of two patents involved is dictum.

In *Trico Products Corporation v. Delman Company*, (S.D. Iowa, 1961), 199 F. Supp. 231, the samples were submitted to the automobile manufacturers for testing and trade reaction. There was no effort or intent to sell the products. In essence, therefore, there was not a competitive use of the invention. The same may be said of *Hutten v. Frank Krementz Co.* (C.A. 3, 1916), 231 Fed. 973, where the eyeglasses were left with Meyrowitz to show only. There



was no subsequent sale of the articles. Instead they were returned. The court's decision may be read as a clear statement that there had been no competitive use of the invention.

In *Connecticut Paper Products v. New York Paper Co.*, (D.C. Md., 1941), 39 F. Supp. 127, negotiations outside the cutoff period were based upon "an imperfect model." It is not clear whether the "imperfect model" constituted a reduction to practice. In this case, as in *F. E. Myers & Bro. Co. v. Gould Pumps, Inc.*, (W.D. N.Y., 1950), 91 F. Supp. 475, the language of *Burke Electric Co. v. Independent Pneumatic Tool Co.*, supra, (C.A. 2, 1916), 234 Fed. 93, is relied upon and the authority of *McCreery Engineering Co. v. Massachusetts Fan Co.*, supra, (C.A. 1, 1912), 195 Fed. 498, is cited.

In the final analysis, we can learn much from *Browning Manufacturing Co. v. Bros., Incorporated* (D.C. Minn., 1962), 134 U.S.P.Q. 231, — F.Supp. —. The machine there was exhibited at a trade show; a pamphlet was distributed stating the price thereof. It should be noted that the case turned upon an issue of publication rather than an on sale issue. However, in considering the latter issue, the court said:

"A sound analysis of the entire testimony, however, would indicate that Bros's activities upon which the plaintiffs rely were directed at sounding out the industry's reaction to the machine and indicated the price at which it would be sold after the company had fully tested the machine, and if the test proved satisfactory then the company would be ready thereafter to place the machine on the market for sale at the proposed price."

The key words are: "*a sound analysis of the entire testimony . . .*" Herein, we believe lies the failure of appellees' analysis of this case.

There was in *Browning* only a general showing to the

trade. There was no specific buyer in view, as there was in the case at bar; hence there was no direct competitive use of the invention. The conclusion is reinforced by the court's finding that the machine was to be fully tested before it could be placed on the market. As in *Burke*, the invention had not reached that ultimate stage where it was to be the subject of competitive use. In our own case, as we have noted, there is no suggestion that Evergreen would defer its decision to buy until after certain tests or experiments had been completed. From early 1951, Evergreen knew it would use the Knowles freezers for its 1951 crops and did.

Appellees have sought to distinguish *Chicopee Manufacturing Corp. v. Columbus Fiber Mills Co.* (M.D. Ga. 1958) 165 F. Supp. 307, on the basis of a sale by sample. Such a position seems to negate the principal theory put forward by appellees that there must be in existence a completed functional and operating specimen of the invention which is available for sale and delivery. The *Chicopee* case, like *Wende v. Horine* (C.A. 7, 1915), 225 Fed. 501; *Magee v. Coca-Cola Co.* (C.A. 7, 1956), 232 F.(2d) 596, and, of course, explicitly, *Philco Corp. v. Admiral Corp.* (D.C. Del., 1961), 199 F. Supp. 797, demonstrate the theory of competitive use as the criterion for application of the on sale doctrine.

It should be noted, parenthetically, that the on sale issue was neither heard nor determined in the Patent Office proceedings, nor could it have been.<sup>10</sup>

Perhaps the authorities show that courts have not always seen that the criterion is the placing of the invention *on sale* rather than any manufacture incorporating the invention. The criterion is not a technical sale as defined by the law of contract or the law of sales. The underlying purpose of the statute is to bar an unwarranted extension of

---

<sup>10</sup> See Rule 292, Rules of Practice, United States Patent Office, 35 U.S.C. Apx. § 1.292, p. 740.

the patent monopoly by a competitive use of an invention out of a profit motive more than one year prior to the date of the patent application.

Under the circumstances, each case must be decided upon its own facts. We believe that we have clearly shown that the invention had been reduced to practice as Knowles himself repeatedly asserted and was final in its form as embodied in the mockup, that appellees intentionally offered their invention for sale in November and December, 1950 and January, 1951 by use of the mockup to numerous persons and especially to Evergreen. We believe the evidence fairly shows a competitive use of the invention when, in January, 1951, Evergreen ordered the two machines which appellees then commenced to build in the image of the mock-up and in fact furnished for scheduled use in June of 1951.

## II. THE BAR OF 35 U.S.C. §135

In appellant's opening brief at page 42-45 and in Questions Presented 2, 3 and 4 (pp. 12-13) and Specifications of Errors 3, 4, 5 and 6 (pp. 13-14), appellant asserts that Knowles was precluded from adding application Claims 25, 26, 27, 28 and 29 on March 23, 1956 to his pending application for the reason that these claims were "for the same, or substantially the same, subject matter" as the McKenzie Patent Claims 3, 6, 7, 10 and 12 and not having been asserted within one year from the date of issue of the McKenzie patent on December 28, 1954, were barred by the provisions of 35 U.S.C. §135, 66 Stat. 801.

Nor did Knowles' amended claims embrace the same or substantially the same subject matter which he had claimed within the critical year following the issue of the McKenzie Patent. In other words, during the critical year, Knowles was claiming something different from the subject matter of his amended claims which were added after the critical year.

### **A. Appellant Is Not Estopped By Res Judicata to Assert This Statutory Bar**

Appellees assert that appellant cannot raise this issue on this appeal for the reason that there has been no appeal from the judgment in C.A. 5092 with which this action was consolidated for trial in the court below. (Brief of appellees, pp. 26-30).

The record is clear that the questions here presented were in issue and were determined adversely to appellant in the court below in this action, C.A. 5171. In "Plaintiff's Contentions as to C.A. 5171" in the Pre-Trial Order it is asserted that the invention contained in Knowles' application claims 25-29, filed more than one year after the date of issue of the McKenzie patent, was substantially different from the invention claimed during the critical year after December 28, 1954 (No. 4, Pre-Trial Order, p.20). Furthermore, it is contended in "Defendant's Contentions as to C.A. 5171":

"The invention of Knowles' patent application Claims 25, 26, 27, 28 and 29, corresponding to Claims 13, 14, 15, 16 and 17 of Knowles' patent No. 2,927,443, respectively, is not different from the invention which has been claimed in Knowles' patent application Ser. No. 289,638 prior to December 28, 1955." (No. 5, Pre-Trial Order, p.22)

and, most important, the Trial Court, in its judgment in C.A. 5171, ruled on this issue by making Conclusion of Law 2, in the identical language of appellees' contention quoted above. It is from this judgment that this appeal is taken.

In C.A. 5092, the issues of priority of invention and fraud in the procurement of the Knowles patent were determined adversely to appellant. From those determinations no appeal has been taken. On this appeal from the judgment in C.A. 5171, appellant asserts the statutory bar to the validity of the Knowles' patent raised by 35 U.S.C. §135 as well as



the bar of 35 U.S.C. §102, both of which issues were tendered to and determined by the court below in this action.

### **B. The Issue Presented**

To avoid the bar imposed by 35 U.S.C. § 135, appellees preface that portion of their brief discussing the pertinent rule with the caption statement "35 U.S.C.A. §135 only requires that *the same general subject matter* have been claimed within a year after patent issues." (p. 34, emphasis added). Section 1101.02(f) of the Patent Office Manual, on which appellees rely and which is supported by the rule of *Rieser v. Williams*, C.C.P.A., 255 F(2d) 419 (1958) formulates the test differently:

"It should be noted that an applicant is permitted to copy a patent claim outside the year period if he has been claiming *substantially the same subject matter* within the year limit."

There is a vast difference between claiming "the same *general* subject matter" and claiming "*substantially the same* subject matter" in prior claims. As properly formulated under the rule of *Rieser v. Williams*, with which we find no necessity for disagreement, the test to be applied in determining whether or not Knowles is barred by 35 U.S.C. §135 from asserting his added application Claims 25-29 more than one year after the date of issue of the MacKenzie patent, presents the inquiry as to whether or not his amended claims filed March 23, 1956 embraced "substantially the same subject matter" as that previously pending in his original application claims.

Phrased in reverse, the issue is presented as to whether or not the differences between the original Knowles application claims and the tardily presented amended claims which became the counts in interference were of "patentable significance" within the rule of *Rieser v. Williams*.

It is appellant's contention that the differences between the original Knowles' application claims and the amended

claims were of "patentable significance" and contrary to appellees' assertion (appellees' brief, p.41), does contend that these added claims did not embrace "substantially the same subject matter" as Knowles' original application claims.

Significantly, appellees' brief offers the court no help or assistance in resolving these issues and, having learnedly developed a generalized statement of law which appellant finds unnecessary to dispute, simply rests upon the fact that the Patent Office Board of Patent Interferences ruled adversely to appellant upon the issue of the bar of 35 U.S.C. §135.

### **C. The Differences Between Knowles' Original and Amended Application Claims Are of Patentable Significance.**

Appellees complain of the failure of the Patent Office to declare an interference during the copendency of the MacKenzie and Knowles applications.<sup>11</sup> The simple answer to this is that Knowles did not, until more than a year after the issuance of the MacKenzie patent, file claims commensurate in scope to those patented to MacKenzie. Examiner Keaveney had both applications on his desk simultaneously and was bound to compare what the two parties were claiming.<sup>12</sup> His inaction indicates the opinion that there was no interference. Examiner Yudkoff cited the MacKenzie patent to Knowles as merely being "of interest." Since Knowles was not claiming the same subject matter as MacKenzie, he, too, saw no interference. Thus Examiners Keaveney and Yudkoff concurred on this important question.

Confronted with the MacKenzie patent, Knowles nevertheless devised a means to get into interference in order to test the issue of priority of invention. He drafted his claims 25-29 and submitted them by amendment (Ex. 28, p. 53 et

---

<sup>11</sup> See p. 33, appllees' brief.

<sup>12</sup>35 U.S.C. § 135, see quotation, p. 34, appellees' brief.

seq.) on March 23, 1956, more than one year after the MacKenzie patent had issued. The Examiner, on April 10, 1956, required Knowles (Ex. 28, p. 77) to *copy* MacKenzie Claims 3, 6, 7, and 10. Under date of May 11, 1956, Knowles replied (Ex. 28, pp. 78 et seq.) that he could not copy the mentioned MacKenzie claims and stated there was "a serious question" (Ex. 28, p. 79, line 14) that he could make MacKenzie's claims. Knowles then revised or patterned his claims more closely after the MacKenzie claims. His original disclosure would not support his copying the MacKenzie patent claims. Amendments were then ordered (Ex. 28, p. 78), the Examiner was personally interviewed (Ex. 28, p. 71) and thereafter the patent interference was declared (Ex. 28, p. 83). It was at this very point that the basic error was made. The patent office overlooked the bar raised by 35 U.S.C. § 135 by failing to recognize that Knowles had not originally or previously as broadly claimed the subject matter of the counts.

To illustrate graphically the differences between Knowles' original application claims and the amended claims or counts in interference (as well as the MacKenzie claims from which they were synthesized), Appendices A, B, C, D, E, F, G and H are attached. Appellees have, as we have noted, failed to make any attempt to meet the vital issue, and have simply assumed, at all times, that there was no substantial difference between the Knowles application and the subsequent amendments—an issue which the actions of Examiners Keaveney and Yudkoff as well as appellant dispute.

Appendices A, B, C and D compare the Knowles application, Claim 5, pending at the time the MacKenzie patent issued, with interference Counts 1, 2, 3 and 4 which were introduced into Knowles' application only on March 23 and May 11, 1956, and with MacKenzie's patent Claims 3, 6, 7 and 10. Similarly, Appendices E, F, G and H compare Knowles' application Claim 6 in each instance with Mac-



Kenzie's patent Claims 3, 6, 7 and 10 and interference Counts 1, 2, 3 and 4 respectively.

Appendices A, B, C and D show that in his Claim 5, Knowles originally claimed a plate freezer comprising "a frame" and "a cage in said frame". MacKenzie's "casing" enclosed a vertical stack of relatively operable refrigerated plates, but no "cage". MacKenzie's "casing" was a broader claim than Knowles' "frame" and "cage" in his plate freezer which was designed to be installed in an insulated room such as was specially constructed by Evergreen. By amendment, Knowles converted MacKenzie's "casing" into "an enclosing structure" and then argued that his "frame" and "cage" was in essence the same. Appellant submits that Knowles' Claim 5 was narrower in a substantial and patentably critical instance from the tardily added claims which ripened into the allowed claims of the Knowles patent and that the counts in interference cannot be equated with the subject matter of Knowles' Claim 5 which was pending during the critical year.

Similarly, as reflected in Appendices E, F, G and H it will be noted that Knowles had introduced his claim as "a plate freezer" without reference to any structure and without reference particularly to "a casing" as called for by MacKenzie or "an enclosing structure" as called for by the four counts in interference. The specific limitation in Knowles' Claim 6 is found in the language "dogs fixed at said station". By comparison with the MacKenzie claims and the several counts in interference it will be seen that in the latter two instances the Claims are broader in the recitation of "stop means" and, in particular, in the fact that they recite no structural limitation that they be "fixed at said station".

It is believed that these comparisons establish, as the patent examiners concluded, that Knowles, during the critical year, was not claiming substantially the same subject

matter as his late-added Claims 25, 26, 27 and 28, which became, respectively, Counts 1 through 4 in interference, and that the Patent Office Board of Patent Interferences erroneously concluded that the addition of Knowles' amended claims which precipitated the interference was not barred by 35 U.S.C. § 135.

### CONCLUSION

In two significant respects appellee Knowles has run afoul of the expressed policy of Congress that dilatory action of a patent applicant shall not be permitted to extend the patent monopoly. Knowles failed to file his original patent application within one year after he had placed his invention on sale as required by 35 U.S.C. § 102 and he failed to claim the subject matter of the MacKenzie claims within one year following the issue of the MacKenzie patent as required by 35 U.S.C. § 135. For these reasons as indicated above and in appellant's opening brief, it is believed that the judgment of the Court below must be reversed.

Respectfully submitted,

ROBERT W. GRAHAM

J. KENNETH BRODY

FORD E. SMITH

*Attorneys for Appellant.*

### CERTIFICATE OF COUNSEL

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

.....  
 ....., Attorney.

21 December, 1962